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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,786	12/13/2001	Laura C. Simmons	P1793R1	9525

7590

05/18/2004

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EXAMINER

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,786

Applicant(s)

SIMMONS ET AL

Examiner

Gerald G Leffers Jr., PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 28-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/20/04; 11/17/03; 6/26/03; 9/22/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of an amendment to the specification, filed on 2/19/2004, in which the Brief Description of the Drawings is amended to include sequence identifiers corresponding to sequences in the figures. The application is now in sequence compliance.

Receipt is also acknowledged of an amendment to the claims, filed 11/14/2003 in response to the previous office action (mailed on 6/17/2003). In the response filed 11/14/2003 claims 1 and 16 were amended. Claims 1-41 are pending, with claims 28-41 withdrawn from consideration as being directed to nonelected inventions.

Any rejection of record in the previous office action not addressed herein is withdrawn. This action is not final as new grounds of rejection are presented herein that were not necessitated by applicants' amendment of the claims in the response filed 11/14/2003.

Information Disclosure Statements (IDS)

Receipt is acknowledged of information disclosure statements filed 6/26/2003, 9/22/2003, 11/17/2003 and 1/20/2004. The signed and initialed PTO Form 1449 for each IDS has been mailed along with this action.

Priority

It is noted that applicants have indicated in the transmittal papers and in the Declaration that the benefit of priority to U.S. Provisional Application 60/256,164, filed 12/14/2000, is desired. However, applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge

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under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 16 recite the limitation of a polynucleotide encoding an "immunoglobulin" where the polynucleotide comprises separate cistrons encoding an "immunoglobulin light chain" and an "immunoglobulin heavy chain". It is unclear whether these terms are intended to specify that the secreted immunoglobulins are *necessarily* full-length molecules, or can also be fragments thereof. For example, the specification teaches that the terms "antibody" and "immunoglobulin" are used interchangeably in the broadest sense and includes various types of full-length antibodies. The specification then goes on to characterize the structural components of full-length natural antibodies (pages 9-10, bridging paragraphs). The specification then uses the terms "full length antibody", "intact antibody" and "whole antibody" to describe antibodies in a substantially intact form that are not various types of antibody fragments well known in the

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art (e.g. scFv, Fab, etc.). Upon reading the specification and the wording of the rejected claims, it appears that the terms recited in claims 1 and 16 are intended to specify that the secreted immunoglobulin is a full-length molecule, but the definitions provided in the specification do not clearly rule out the possibility that smaller fragments are intended as well. It would be remedial to amend the specification to clearly indicate which of the two possibilities are intended by the recited terms.

Examiner's Note

It is noted that the amendment filed 11/14/2003 by fax is barely legible, at least in part due to the apparently small font used in typing the claims. This problem is exacerbated in the new Image File Wrapper system where the submitted papers are scanned into an electronic file. It is respectfully requested that in response to this action a complete set of claims that are in a slightly larger font be submitted in order to facilitate examination and to avoid problems with the printer once the claims are allowed.

Conclusion

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr., PhD whose telephone number is (571) 272-0772. The examiner can normally be reached on 9:30am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gerald G Leffers Jr., PhD
Primary Examiner
Art Unit 1636


GERRY LEFFERS
PRIMARY EXAMINER